IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)		
Moore et al.	)		
	)	Examiner:	Heneghan
Serial No.: 09/775,745	)		
	)	Group Art Unit:	2134
Filed: February 2, 2001	)		
	)		
For: Solid-State Memory Device	)		
Storing Program Code and	)		
Methods for Use Therewith	)		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants request review of the final rejection of January 28, 2008 in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets. No more than five (5) pages are provided.

REMARKS

I.   Introduction

It is black letter patent law that "to anticipate a claim, [a prior art] reference must teach

every element of the claim." MPEP 2131.01 (emphasis added). However, the Examiner based

the anticipation rejections of independent Claims 3, 7, 15, and 88 on a different, incorrect

standard: "If the prior art structure is *capable of performing* the intended use, then it meets the

claim. Since [the prior art reference] *may be configured* [to meet the claim limitation], it

anticipates the claims." January 28, 2008 Office Action, page 7 (emphasis added). Because the

incorrect standard was used, Applicants respectfully request reversal of these rejections.

II.   Inoue et al. Does Not Teach Every Element of Independent Claims 3, 7, 15, and 88

Independent Claims 3, 7, 15, and 88 were rejected under 35 U.S.C. § 102(b) as being

anticipated by U.S. Patent No. 6,157,948 to Inoue et al. Each of these claims recites that the host

device requires the program code stored in a solid-state memory device to read data stored in the

solid-state memory device. However, Inoue et al. does not teach these elements. In the Office

Action, it was asserted that Inoue et al. teaches an audio-video player, which presumably

corresponds to the recited host device, and a storage unit storing program code and additional

program segments. According to the Office Action, the program code in the storage unit is used

to fetch the additional program segments in the storage unit and provide them to the audio-video

player. However, as argued in Applicants' prior response, the fact that the program code is

written to fetch the program segments in the storage unit does not mean that the audio-video

player cannot otherwise read the program segments in the storage unit. The audio-video player,

on its own, may not be able to perform the exact function performed by the program code, but

there is no cited teaching that the audio-video player *requires* the program code to read the

program segments. Accordingly, Inoue et al. is not sufficient to anticipate independent Claims 3, 5, 7, and 88.

III.   An Incorrect Standard Was Used to Reject Independent Claims 3, 7, 15, and 88

In response to the above arguments, the Examiner stated that Inoue et al. can still anticipate independent Claims 3, 7, 15, and 88 even though it does not teach every element in those claims: "If the prior art structure is *capable of performing* the intended use, then it meets the claim. Since Inoue's invention *may be configured* such that the invention cannot work without the program reading the program segments, it anticipates the claims." January 28, 2008 Office Action, page 7 (emphasis added). The Examiner applied an incorrect standard.

MPEP 2131.01 sets forth the correct standard for an anticipation rejection: "'A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.'" MPEP 2131 (emphasis added) quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). By relying upon the "capable of performing" argument, the Examiner is implicitly admitting that Inoue et al. does not expressly describe the claim elements discussed above. Further, the Examiner admits that the claim elements are not necessarily present/inherent in Inoue et al. by arguing that Inoue et al. "*may be configured*" to include the claim elements. "The fact that a certain result or characteristic <u>may</u> occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP 2112 (emphasis in original). "'To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference. . . . The mere fact that a certain thing may result from a given set of circumstances is not sufficient." MPEP 2112 quoting *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

IV.   The Other Independent Claims

It appears that the rejections of some of the other independent claims were also based on an incorrect standard. For example, independent Claims 37 and 39 were also rejected as being anticipated by Inoue et al. even though Inoue et al. does not teach every element recited in those claims. Independent Claim 37 recites using program code stored in a solid-state memory device to store data *only in* the solid-state memory device, and independent Claim 39 recites a solid-state memory device comprising program code operative to enable a host device to store data *only in* a certain portion of the solid-state memory device. As previously argued by Applicants, Inoue et al. does not teach these elements. Nevertheless, the Examiner has maintained these rejections without addressing the "missing element" issue. Apparently, the Examiner is maintaining the rejections because Inoue et al. "may be capable" of performing the missing element. Again, this is an incorrect standard, and the rejections should be reversed.

The 35 U.S.C. § 103(a) rejections also appear to be based on an incorrect standard. For example, like the claims discussed above, independent Claims 16 and 18 recite that the host device requires the program code stored in a solid-state memory device to data stored in the solid-state memory device. The basis of the 35 U.S.C. § 103(a) rejections of these claims is that Inoue et al. teaches that element (the secondary reference in the rejection was relied upon for a different claim element). However, as discussed above, Inoue et al. does not teach that element.
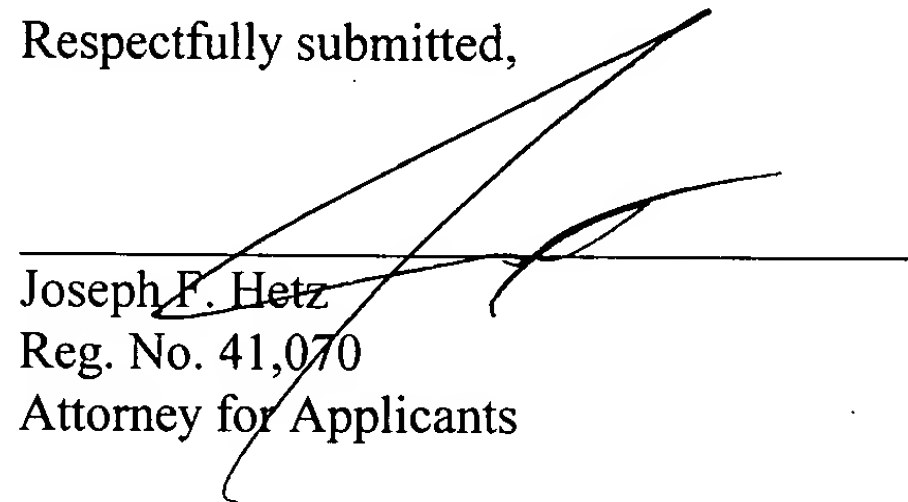
V.   Conclusion

Because the incorrect standard was used to reject independent Claims 3, 7, 15, and 88 (and other independent claims), Applicants respectfully submit that the rejections of those claims and their dependent claims be withdrawn and that this application be passed to allowance.

Reconsideration is respectfully submitted. If there are any questions, please contact the undersigned attorney at (312) 321-4719.

Dated: April 17, 2008

Respectfully submitted,

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